United States Court of Appeals

for the

District of Columbia Circuit

TRANSCRIPT OF RECORD

BRIEF FOR APPELLANT AND JOINT APPENDIX

IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT.

United States Court of Appeals
For the
District of Columbia Circuit
FILED MAY 14-1952
Joseph W. Stewart
CLERK

No. 11,401

HOMER L. CUPPLES, *Appellant*,

v.

JOHN A. MARZALL, Commissioner of Patents, *Appellee*.

Appeal from the District Court of the United States for the District of Columbia

HOMER L. CUPPLES,
Appellant,
208 Belle Haven Road,
Alexandria, Virginia.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

STATEMENT OF QUESTIONS PRESENTED.

The question is whether the Commissioner of Patents may lawfully provide by Patent Office rule that persons who have served for three years in the examining corps of the Patent Office may be admitted to practice before the Patent Office without taking and passing a written examination which is required of all other applicants for registration; and whether, consequently, the Commissioner erred in requiring appellant to take and pass the written examination while admitting to practice without the taking of the examination persons who had served for three years in the examining corps of the Patent Office.

INDEX.

	Page
Statement of Questions Presented	i
Jurisdictional Statement	1
Statement of Case	3
Statutes and Rules Involved	4
Statement of Points	6
Summary of Argument	6
Argument:	8
Point I	8
Point II	13
Point III	13
Conclusion	13

TABLE OF CASES, STATUTES AND RULES.

Cupples v. Marzall, Commissioner of Patents, 101 F. S. 579, 92 U.S.P.Q. 169 ..... 2, 4

Hart, James "An Introduction to Administrative Law", 2d Ed., 1950, p. 330 11-12

Horton, In Re, C.C.P.A., 58 F. 2d 682 8

Lynch v. Tilden Produce Co., 265 U.S. 315, 44 S.C. 488 10

Manhattan General Equipment Co. v. Commissioner of Internal Revenue, 297 U.S. 129, 56 S.C. 397 8

Miller v. United States, 294 U.S. 435, 55 S.C. 440 11

Morrill v. Jones, 106 U.S. 466, 1 S.C. 423 9

Revised Statutes, Sec. 487 2

Rules of Practice of the United States Patent Office in Patent Cases, Rule 341(c), 37 C.F.R. 1.341(c) ..3, 6, 7, 8, 9, 12, 13

Rules of the United States District Court for the District of Columbia, Rule 95 5

Waite et al. v. Macy et al., 246 U.S. 606, 38 S.C. 395 10

5 U.S.C. 1001-1011 2

28 U.S.C. 1291 2

35 U.S.C. 11 ..... 2, 4, 7

IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT.

No. 11401.

HOMER L. CUPPLES, *Appellant*,

v.

JOHN A. MARZALL, Commissioner of Patents, *Appellee*.

Appeal from the District Court of the United States for the District of Columbia.

BRIEF FOR APPELLANT.

JURISDICTIONAL STATEMENT

Appellant applied to the Commissioner of Patents for admission to practice before the United States Patent Office (Tr. 18-19), and on August 6, 1951 took a required written examination. (App. 3, 5, 8) On October 30, 1951 the Committee on Enrollment of the Patent Office notified appellant that he had not attained a passing grade in the written

examination. (Tr. 13) (App. 3, 5) On November 3, 1951 appellant filed in the Patent Office a petition requesting review of the holding of the Committee on Enrollment. (Tr. 15-16) (App. 3, 5) On November 15, 1951 the Committee on Enrollment of the Patent Office advised appellant that his petition had been referred to said committee and that the committee affirmed the original decision. (Tr. 14) (App. 3, 5)

Appellant filed his complaint in the United States District Court for the District of Columbia against John A. Marzall, Commissioner of Patents, on November 27, 1951 (App. 2), within the 30 day period allowed by Rule 95 of the Rules of the United States District Court for the District of Columbia, praying that the court review and reverse the action of the Commissioner and hold invalid Rule 341(c) of the Patent Office. Jurisdiction of the district court arises under Revised Statutes Sec. 487, as amended; 35 U.S.C. 11; Administrative Procedure Act, Act of June 11, 1946, ch. 324, 60 Stat. 237-244, as amended; 5 U.S.C. secs. 1001-1011.

On January 18, 1952 the district court entered judgment for the defendant and dismissed the complaint. (App. 20) *Cupples* v. *Marzall, Com. of Patents,* 101 F. S. 579, 92 U. S. P. Q. 169.

On January 26, 1952 appellant filed motion for amendment of findings of fact and conclusions of law. (Tr. 42)

On January 30, 1952 the district court entered its order denying appellant's motion for amendment of findings. (Tr. 42)

On March 20, 1952 appellant filed notice of appeal to this court (Tr. 44), and on the same day filed his statement of points (Tr. 45) and designation of record on appeal. (Tr. 46)

Jurisdiction of this court arises under new Title 28 U.S.C. sec. 1291.

STATEMENT OF THE CASE.

Appellant in the summer of 1951 applied to the Commissioner of Patents for admission to practice before the United States Patent Office and submitted the required information, certificates and reference. Rule 341(c) of the Rules of Practice of the United States Patent Office in Patent Cases promulgates as a requirement for registration that a written examination which is held from time to time must be taken and passed. Appellant was admitted to and took this examination on August 6, 1951. (App. 3, 5, 8)

On October 30, 1951 appellant was advised by the Committee on Enrollment of the Patent Office that he had not received a passing grade in the written examination. (Tr. 13) (App. 3, 5)

On November 3, 1951 appellant filed in the Patent Office a petition to the Commissioner asking a review of the examination papers, both as to the merits and as to the clerical operations involved. (Tr. 15-16) (App. 3, 5) On November 15, 1951 appellant was informed by the Committee on Enrollment that his petition had been referred to the Committee on Enrollment and that the committee affirmed the original decision. (Tr. 14) (App. 3, 5)

Rule 341(c) of the Rules of Practice of the United States Patent Office in Patent Cases further provides that the written examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office, and in accordance with this provision the Commissioner from time to time admits to practice before the Patent Office, without the taking of this examination, persons who have served for three years in the examining corps of the Patent Office. (App. 8)

On November 27, 1951 appellant filed his complaint in the United States District Court for the District of Columbia, (App. 2-5) asking the court, *inter alia,* to find and to hold that the Commissioner erred in requiring him to take and to pass the written examination of August 6,

1951, and to hold that Rule 341(c) of the Rules of Practice of the Patent Office is invalid and void. (App. 4)

On January 10, 1952 Judge Keech filed his Opinion (App. 11-17) holding, *inter alia,* that Rule 341(c) of the Patent Office is valid and not discriminatory. (App. 12-13)

On January 18, 1952 the district court entered judgment for the defendant (App. 20) holding as a matter of law that Rule 341(c) of the Patent Office is reasonable and valid and not discriminatory in that taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office. (App. 19) *Cupples* v. *Marzall, Com. of Patents,* 101 F. S. 579, 92 U. S. P. Q. 169.

Appellant moved for amendment of findings of fact and conclusions of law on January 26, 1952. (Tr. 42)

On January 30, 1952 the district court denied appellant's motion for amendment of the findings. (Tr. 42)

On March 20, 1952 appellant filed notice of appeal to this honorable court (Tr. 44), filed appellant's statement of points (Tr. 45) and filed appellant's designation of record on appeal. (Tr. 46)

STATUTE AND RULES INVOLVED.

Statute.

"35 U.S.C. 11; R.S. 487. Patent Agents or Attorneys; Rules and Regulations For; Suspension or Exclusion From Practice.

The Commissioner of Patents, subject to the approval of the Secretary of Commerce, may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and

are likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the Office. The Commissioner of Patents may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before his office any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who refuses to comply with the said rules and regulations, or who shall, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the office, by word, circular, letter, or by advertising. The reasons for any such suspension or exclusion shall be duly recorded. The action of the commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the district court of the United States for the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine." (R.S. sec. 487; Act of February 14, 1903, ch. 552, sec. 12, 32 Stat. 830; Act of February 18, 1922, ch. 58, sec. 3, 42 Stat. 390; Act of June 25, 1936, ch. 804, 49 Stat. 1921)

Rule of Court.

Rules of the United States District Court for the District of Columbia. Rule 95.* Review of Orders as to Admission and Exclusion of Practitioners Before Patent Office.

"A person refused recognition to practice or suspended or excluded from practice before the Patent Office may file his petition in this court against the Commissioner of Patents for a review of such action within thirty days after date of the order recording the Commissioner's action * * *. * * * Prior to the time for hearing the petitioner shall file a certified copy of the record and proceedings be-

* Adopted June 26, 1945.

fore the Patent Office, which shall constitute the sole basis for the court's review."

Administrative Regulation.

Rules of Practice of the United States Patent Office in Patent Cases (as amended February 24, 1950). Rule 341(c). 37 C.F.R. 1.341(c).

"*Requirements for registration.* .... an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office."

STATEMENT OF POINTS.

1. The district court erred in holding that Rule 341(c) of the Rules of Practice of the United States Patent Office in Patent Cases, 37 C.F.R. 1.341(c), is reasonable and valid and is not discriminatory in that taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office. (Tr. 45, point 1)

2. The district court erred in refusing and neglecting to adjudge that the defendant erred in requiring plaintiff to comply with the provisions of Rule 341(c) of the Patent Office as a prerequisite to admission to practice before the United States Patent Office, and more particularly in requiring plaintiff to take and pass the written examination held for that purpose on August 6, 1951. (Tr. 45, point 2)

3. The district court erred in dismissing the complaint in this action. (Tr. 45, point 3)

SUMMARY OF ARGUMENT.

In the process of rule-making an administrative authority may lawfully act only in accordance with the terms of the governing statute, and the content of the rules must

lie within the powers which are expressly or impliedly conferred therein. Rules are *ultra vires* which add to or subtract from the provisions of the governing statute.

The authority of the Commissioner of Patents to make rules and regulations governing the admission of practitioners before the Patent Office is derived from the statutory provisions embodied in 35 U.S.C. 11, and the statutes do not expressly or by implication authorize the Commissioner to classify applicants into species to be examined and evaluated by different methods or by different standards. The provision of Rule 341(c) of the Patent Office that persons who have served for three years in the examining corps of the Patent Office may be admitted to registration without taking the written examination which is required of all other applicants, is equivalent to the classification of applicants into two groups, the members of one group being eligible for admission by the Commissioner without the taking of a written examination, whereas members of the second group are ineligible for such admission. Appellant submits that this constitutes an unauthorized addition to and modification of the governing statute, and is *ultra vires*.

If Rule 341(c) be held invalid in so far as it purports to classify applicants for registration in the manner above stated, it follows that the Commissioner erred in applying the rule to appellant and requiring him by authority thereof to take and pass the written examination of August 6, 1951 as a prerequisite to admission to registration, and that the district court erred in failing to find and hold that the Commissioner erred in so doing.

Further, in view of the fact that the Commissioner has denied appellant admission to registration on the ground that he did not pass the written examination of August 6, 1951, it is clear that the error of the Commissioner in requiring appellant to take and pass this examination is prejudicial and reversible error, and that the district court erred in dismissing the complaint in this action.

ARGUMENT.

I. Providing by Patent Office Rule that persons who have served for three years in the examining corps of the Patent Office may be admitted to practice before the Patent Office without taking the written examination which is required of all other applicants is beyond the scope of the power conferred, and the rule is ultra vires.

The acts of the Commissioner in the case at bar are claimed by the defendant (App. 8) to be specifically authorized by Rule 341(c) of the Patent Office. Appellant agrees that the acts of the Commissioner in this respect are so authorized, if the rule itself is valid. The question in the case at bar, therefore, is not whether the Commissioner has acted with sound discretion; the question is, has the Commissioner in promulgating Rule 341(c) acted within the scope of the rule-making power conferred upon him by Congress, as expressed in the words of the statute? Such rules have the force and effect of law only if they lie within the scope of the power conferred. *In re Horton,* C.C.P.A., 58 F. 2d 682.

The power of an administrative officer or board to administer a federal statute and to prescribe rules and regulations to that end is not the power to make law, for no such power can be delegated by Congress, but the power to adopt regulations to carry into effect the will of Congress *as expressed by the statute.* A regulation which does not do this, but operates to create a rule *out of harmony with the statute,* is a mere nullity. *Manhattan General Equipment Co.* v. *Commissioner of Internal Revenue,* 297 U.S. 129, 56 S.C. 397.

The authority of the Commissioner of Patents to promulgate Office Rule 341(c), relating to patent agents and attorneys, is derived from the statutory provisions embodied in 35 U.S.C. 11 (supra, p. 4). The Commissioner is thereby authorized to inquire into the character, repute, qualifications and competence of agents and attorneys who

desire to be recognized before the Patent Office, and to prescribe rules and regulations governing the recognition of such agents and attorneys. It may be presumed that Congress intended that such inquiry should be carried out in an impartial, uniform and non-discriminatory manner. There is no authorization, express or implied, for the classification of applicants into groups subject to different standards and methods of inquiry. Appellant submits that the provision of Rule 341(c) that persons who have served for three years in the examining corps of the Patent Office may be excused from taking the written examination which is required of all other applicants operates to create a rule which is out of harmony with the plain intent and purpose of the statute.

The case of *Morrill* v. *Jones,* 106 U.S. 466, 1 S.C. 423 illustrates the principle that the Supreme Court interprets the rule-making power as confined to providing the *means* by which the statutory provision shall be administered as it stands, *without addition or modification.* In this case the statute provided that "Animals alive, specially imported for breedinig purposes from beyond the seas, shall be admitted free, upon proof thereof satisfactory to the Secretary of the Treasury, and under such regulations as he may prescribe." The Secretary of the Treasury promulgated a regulation under authority of the statute which provided that before a collector should admit such animals free, he must "be satisfied that the animals are of superior stock, adapted to improving the breed in the United States." In holding the regulation invalid the Supreme Court said:

> "The Secretary of the Treasury cannot by his regulations alter or amend a revenue law. All he can do is to regulate the mode of proceeding to carry into effect what Congress has enacted. In the present case we are entirely satisfied the regulation acted on by the collector was in excess of the power of the Secretary. The statute clearly includes animals of all classes. The regulation seeks to confine its operation to animals

> of 'superior stock'. This (is) manifestly an attempt to put into the body of the statute a limitation which Congress did not think it necessary to prescribe. * * * In our opinion, the object of the Secretary could only be accomplished by an amendment of the law. That is not the office of a treasury regulation."

In *Waite et al.* v. *Macy et al.*, 246 U.S. 606, 38 S.C. 395, the statute made unlawful the importation of inferior teas, provided for the establishment of standards of purity, quality, and fitness for consumption, and gave the Secretary of the Treasury power to enforce the act by appropriate regulations. The Secretary promulgated a regulation which included a test for the discovery of artificial coloring matter (the test not being included in the statute) and which provided for the rejection of tea containing any such coloring matter. The Supreme Court held the regulation to be in excess of the Secretary's powers.

In *Lynch* v. *Tilden Produce Co.*, 265 U.S. 315, 44 S.C. 488, the question was whether a certain lot of butter was adulterated within the meaning of the statute, which provided that adulterated butter included: (1) a grade produced by treatment with a chemical to deodorize or remove rancidity; (2) a butter product mixed with a foreign substance to lessen its cost; and (3) "any butter in the manufacture or manipulation of which any process or material is used with intent or effect of causing the absorption of abnormal quantities of water, milk, or cream." The Commissioner of Internal Revenue promulgated a regulation which included the following: "* * * This being the case it becomes necessary to adopt a standard for moisture in butter, which shall in effect represent the normal quantity. It is therefore held that butter having 16 percent or more of moisture contains an abnormal quantity and is classed as adulterated butter." The Supreme Court held the regulation void as an unauthorized addition to the statutory definition of adulterated butter.

In *Miller* v. *United States,* 294 U.S. 435, 55 S.C. 440, the Veterans Administration promulgated a regulation that, under war risk insurance, loss of one hand and one eye should be deemed permanent disability. The Supreme Court held the regulation invalid because not within the legislative grant of power to make regulations to carry out the purposes of the War Risk Insurance Act. The Supreme Court there says, "* * * It is not, in the sense of the statute, a regulation at all, but legislation. * * * The vice of the regulation, therefore, is that it assumes to convert what in the view of the statute is a question of fact requiring proof into a conclusive presumption which dispenses with proof and precludes dispute. This is beyond administrative power. * * *" Appellant submits that the factual situation in the case at bar is closely analogous to that in *Miller* v. *United States,* in that in the case at bar the regulation dispenses with proof of certain qualifications of an applicant upon the basis of a legal presumption which is set up by administrative rule. The legal objection to the establishment of such a presumption by administrative rule is, of course, entirely independent of the reasonableness of a factual conclusion that any person who has served for three years in the examining corps of the Patent Office is capable of passing the written examination which is required of other applicants.

Hart presents the following summary of the law: "*Regulations void if ultra vires.* If the delegation of rule-making * * * is found to be constitutional, the second requirement is that the administrative authority act strictly in accord with its terms. Otherwise, the administrative authority has acted ultra vires, and its regulations are void. This also is a jurisdictional question which the courts are always free to examine, and authoritatively to determine in a proper case. In so doing, they construe the statute and test the official action by the statute as so construed. If the statute expressly requires procedures such as findings or notice and a hearing, these are jurisdictional prerequi-

sites to the exercise of the rule-making powers granted, and failure to comply with them makes the issuance of regulations ultra vires. Their issuance may also be ultra vires because of their content. To test them in this respect it is necessary to construe them. As so construed, they must not add to, subtract from, supersede, or otherwise conflict with the provisions of the governing statute or of any other statutory law, unless, of course, the power granted is one expressly to amend the statutes in specified respects. They must not deal with matters not intended by the delegation, or go outside the limits fixed or implied therein. They must not allow arbitrary action in particular cases. Finally, they must not be unreasonable." (Hart, James. "An Introduction to Administrative Law", 2nd Ed., 1950, p. 330)

Appellant submits that Rule 341(c) of the Patent Office is ultra vires in that it constitutes an addition to and modification of the governing statute. In the absence of statutory authority the rule classifies applicants into two groups, subject to different standards and methods of examination. One group is composed of those persons who have served for three years in the examining corps of the Patent Office, and members of this group are eligible for admission to registration without taking a written examination. The second group is composed of all other applicants for admission to registration, and members of this group are not so eligible and must perforce take and pass the written examination. In thus substituting for an issue of fact a legal presumption which is not prescribed by the governing statute, the rule lies beyond the scope of the power of the Commissioner and is invalid.

II. The Commissioner of Patents erred in requiring appellant to take and pass the written examination of August 6, 1951 as a prerequisite to admission to practice before the Patent Office.

Upon the assumption that Rule 341(c) of the Patent Office is invalid in so far as it assumes to determine whether or not a specific applicant must take and pass the written examination, it follows that the Commissioner erred in applying the rule to appellant and requiring him by authority thereof to take and pass the written examination of August 5, 1951 as a prerequisite to admission to registration, and that the district court erred in failing to find and hold that the Commissioner erred in so doing. (See App. 4, prayer (3))

III. The district court erred in dismissing the complaint in this action.

In view of the fact that the Commissioner has denied appellant admission to practice on the ground that he did not pass the written examination of August 6, 1951, it is clear that the error of the Commissioner in requiring him to take and pass this examination was prejudicial and reversible error, and that the district court erred in dismissing the complaint in this action. (App. 20)

CONCLUSION.

For the reasons heretofore stated it is respectfully submitted that there was error in the rulings and judgment of the lower court and the same should therefore be reversed. Appellant further submits that this Court should hold that Rule 341(c) of the Patent Office is invalid in providing that written examinations may be waived in the case of persons who have served for three years in the examining corps of the Patent Office and that all other applicants must take and pass a written examination, and that,

consequently, the Commissioner of Patents erred in applying said rule to appellant and under authority thereof requiring him to take and pass the written examination of August 6, 1951 as a prerequisite to admission to registration.

HOMER L. CUPPLES,
Appellant,
208 Belle Haven Road,
Alexandria, Virginia.

APPENDIX

INDEX TO APPENDIX.

	Page
Joint Appendix	1
Complaint filed in district court	2
Answer to complaint	5
Amended complaint filed in district court	9
Answer to amended complaint	10
Pre-trial proceedings	7
Opinion	11
Findings of fact	17
Conclusions of law	19
Judgment	20

IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT.

No. 11,401.

HOMER L. CUPPLES, *Appellant*,

v.

JOHN A. MARZALL, Commissioner of Patents, *Appellee*.

Appeal from the District Court of the United States for the District of Columbia

---

JOINT APPENDIX

---

1 Filed Nov. 27, 1951

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action File No. 4905-51

HOMER L. CUPPLES, 208 Belle Haven Road, Alexandria, Virginia, *Plaintiff*

v.

JOHN A. MARZALL, Commissioner of Patents, United States Patent Office, Washington 25, D. C., *Defendant*

Complaint

PETITION FOR REVIEW OF COMMISSIONER'S ACTION REFUSING TO ADMIT PLAINTIFF TO PRACTICE BEFORE THE UNITED STATES PATENT OFFICE AND FOR MANDATORY INJUNCTION REQUIRING THE COMMISSIONER TO ADMIT PLAINTIFF TO PRACTICE

1

This action arises (a) under the patent laws of the United States, more particularly under Revised Statutes Section 487 as amended (35 U.S.C. 11) and (b) under the general power of the Court to correct by its writ of mandamus an exercise of power in an unlawful and arbitrary manner by an inferior court or a quasi-judicial officer.

2

Plaintiff is a citizen of the United States and a resident of the County of Fairfax, State of Virginia.

3

Defendant John A. Marzall is the Commissioner of Patents.

2 4

Prior to July 6, 1951 plaintiff applied in writing to the defendant Commissioner of Patents, on a form supplied

by him, for admission to practice before the United States Patent Office.

5

Upon the basis of said application (paragraph 4, supra) defendant admitted plaintiff to the examination held August 6, 1951 in the city of Washington, D. C. for admission to practice before the United States Patent Office.

6

Plaintiff attended said examination (Paragraph 5, supra) and wrote answers to each and every question.

7

Plaintiff alleges, upon information and belief, that he wrote a passing examination .

8

Under date of October 30, 1951 plaintiff was informed in writing by Thomas F. Murphy, Chairman, Committee on Enrollment, acting under authority of the defendant Commissioner of Patents, that he did not attain a passing grade in said examination (paragraph 5, supra).

9

On November 3, 1951 plaintiff filed in the United States Patent Office a petition to the Commissioner of Patents requesting that he determine the correctness of identity of the examination papers attributed to plaintiff, determine the correctness of the clerical operations involved in computing and transcribing the grade thereof, and review the examination papers of plaintiff upon the merits thereof.

3 10

Under date of November 15, 1951 plaintiff was informed in writing by C. W. Moore, Acting Chairman, Committee on Enrollment, that said requested review (paragraph 9, supra) had been referred to the Committee on Enrollment, and that their review affirmed the original decision.

11

Plaintiff alleges, upon information and belief, that the examination papers which plaintiff wrote and submitted on August 6, 1951 have not at all times been kept in the custody of an official of the Patent Office.

4 WHEREFORE plaintiff prays:

(1) That the Court review and reverse the action of the defendant in refusing to admit plaintiff to practice before the United States Patent Office upon his application filed prior to July 6, 1951 and supplemental papers in support thereof.

(2) That the Court adjudge that the defendant erred in admitting into evidence certain papers alleged by the defendant to be the examination papers written and submitted by plaintiff on August 6, 1951.

(3) That the Court adjudge that the defendant erred in requiring plaintiff to comply with the provisions of Rule 341(c) of the Rules of Practice of the United States Patent Office in Patent Cases as a prerequisite to admission to practice before the United States Patent Office, and more particularly in requiring plaintiff to take and pass the written examination held August 6, 1951 for that purpose, and that said Rule 341(c) is invalid and void as being contrary to law.

(4) That the court adjudge that the record in the proceedings before the defendant Commissioner of Patents shows that he is of good moral character and in good repute, and possessed of the necessary qualifications to enable him to render to applicants and other persons valuable service, and is likewise competent to advise and assist applicants or other persons in the presentation or prosecution of their applications or other business before the Patent Office.

(5) That the Court require the defendant Commissioner of Patents to admit plaintiff to practice before the United States Patent Office.

5 6. That the Court order the Commissioner of Patents to certify to this Court the record of these proceedings before the Commissioner.

7. That the Court receive briefs on plaintiff's behalf.

8. That the plaintiff have such other and further relief as may be just and equitable.

HOMER L. CUPPLES
208 Belle Haven Road
Alexandria, Virginia
Plaintiff

* * * * * * * * * *

6 Filed Dec. 1, 1951

Answer to the Complaint

To the Honorable the Judges of the United States District Court for the District of Columbia.

1. The defendant admits that this action arises under Section 487 of the Revised Statutes, 35 U.S.C. 11. He denies that the Court has jurisdiction to act in this case by writ of mandamus since an adequate remedy is provided by the statute previously referred to.

2, 3, 4, 5, 6. He admits the allegations of paragraphs 2, 3, 4, 5, and 6.

7. He denies the allegations of paragraph 7.

8, 9, 10. He admits the allegations of paragraphs 8, 9, and 10.

7 11. He states that the examination papers referred to in paragraph 11 of the complaint were collected by the Civil Service Commission and delivered by that agency to the Patent Office. He states that since such delivery, the papers have been continuously in the custody of an official of the Patent Office.

FURTHER ANSWERING, the defendant states that the plaintiff's examination papers were carefully and independently graded by each of two competent officials of the Patent Office, each of whom accorded them a grade less than the passing grade. He further states that pursuant to the plaintiff's petition of November 3, 1951, referred to in paragraph 9 of the complaint, the papers were reviewed to the extent that it was determined that no error was made in identifying the papers or computing and transcribing the grades.

While no answer is made herein to the prayers attached to the complaint, it is noted with respect to prayer No. 6, that Rule 95, appearing under Title VIII of the rules of this Court, which rule was promulgated to govern cases of this character, provides that "The petitioner shall file a certified copy of the record and proceedings before the Patent Office."

Respectfully submitted,

E. L. REYNOLDS
Solicitor, U. S. Patent Office,
Attorney for Defendant.

November 30, 1951

8 November 30, 1951

I hereby certify that a copy of the foregoing ANSWER TO THE COMPLAINT was mailed today to the plaintiff, Mr. Homer L. Cupples, 208 Belle Haven Road, Alexandria, Virginia.

E. L. REYNOLDS
Solicitor.

* * * * * * * * * *

24 Filed Dec. 14, 1951

Pretrial Proceedings

STATEMENT OF NATURE OF CASE:

Plaintiff brings this action under 35 USC 11, to review the action of the defendant in refusing to admit plaintiff to practice before the Patent Office. Plaintiff says in the summer of 1951, he applied in writing to the defendant for permission to practice before the Patent Office, submitted the required preliminary papers and was admitted to and took the written examination conducted by the Civil Service Comm. on Aug. 6, 1951. Plaintiff says that the examination papers for this examination were collected by representatives of the Civil Service Comm. and forwarded to the Patent Office. On Oct. 30, 1951, plaintiff was advised that he had not received a passing grade in the written examination and on Nov. 3, 1951, plaintiff filed a petition with the defendant, asking a review of the examination papers, both as to the merits and as to the clerical end thereof. On Nov. 15, 1951, plaintiff was informed that his petition had been referred to the Committee on Enrollment and that the committee had affirmed the original decision, i.e. that he had not made a passing grade. Plaintiff asks the court to reexamine his papers and to reverse the action of the Commissioner refusing him permission to practice; that the Court judge that deft. erred in admitting in evidence in consideration of his examination papers allegedly written by plaintiff; that deft. erred in requiring plaintiff to take a written examination and in this regard plaintiff contends that Rule 341, paragraph C, of the Rules of the Patent Office is void and contrary to law. Plaintiff seeks by Mandamus to require deft. to admit him to practice before the Patent Office.

25 The deft. denies plaintiff's right to mandamus contending that the Statute and Rule 95 of this Court afford plaintiff a judicial review of deft.'s action and that this review is an adequate remedy without the

issuance of a mandamus. Deft. challenges plaintiff's contention as to the illegality of Rule 341, paragraph C, of the Patent Office and relies upon 35 USC 11, as affording the deft. the right to establish rules and regulations relating to persons practicing before the Patent Office. Deft. says that on Mar. 1, 1949, he issued Rule 341-C, which established certain requirements including the taking and passing of examination and that this action approved by the Sec'y. of Commerce establishes the validity and legality of this action. Deft. further challenges the right of the plaintiff to compel the deft. to certify its records of plaintiff's examination questions and answers thereto to the plaintiff on the ground that these papers are confidential documents to which plaintiff is not entitled to have access. The deft. says that he will present copies of these documents to the Court for the Court's review but that pltf. is not, himself, to see these documents.

STIPULATIONS: By agreement of counsel for the respective parties, present in Court, it is ordered that the subsequent course of this action shall be governed by the following stipulations unless modified by the Court to prevent manifest injustice:

The following facts are stipulated:

1. The plaintiff has sufficient basic training in scientific matter to entitled him to take the examination.

2. At the examination, taken by plaintiff on Aug. 6, 1951, the plaintiff's papers were collected by persons employed by the Civil Service Comm. who later delivered the papers to the Patent Office.

3. That deft. from time to time admits to practice before the Patent Office without the taking of an examination. Persons who have served for 3 years in the Examining Corps of the Patent Office.

4. The plaintiff at no time since the examination has been permitted to see his or any other examination papers.

Dated Dec. 14, 1951

.....
Pretrial Justice.

Attorneys authorized to act:

.....
Plaintiff.

.....
Defendant.

* * * * * * * * * *

26 Filed Jan. 2, 1952

Complaint
(amended)

PETITION FOR REVIEW OF COMMISSIONER'S ACTION REFUSING TO ADMIT PLAINTIFF TO PRACTICE BEFORE THE UNITED STATES PATENT OFFICE AND FOR MANDATORY INJUNCTION REQUIRING THE COMMISSIONER TO ADMIT PLAINTIFF TO PRACTICE

Plaintiff for his amended complaint served pursuant to an order of this court dated January 2, 1952, alleges:

The entire original COMPLAINT is hereby incorporated into and made a part of this amended complaint, with the addition of the following paragraph 12, to be inserted on page 3 thereof immediately following paragraph 11:

12

Plaintiff alleges that he has performed all lawful conditions precedent to admission to practice before the United States Patent Office and that defendant continues in an

unlawful, unreasonable, and arbitrary manner, to refuse to admit plaintiff to practice before the Patent Office.

HOMER L. CUPPLES
Plaintiff
208 Belle Haven Road
Alexandria, Virginia

27 PROOF OF SERVICE

January 2, 1952

I hereby certify that a copy of the above COMPLAINT (amended) was served today upon the defendant by handing a copy thereof to attorney for defendant, E. L. Reynolds.

HOMER L. CUPPLES
Plaintiff
208 Belle Haven Road
Alexandria, Virginia

* * * * * * * * * *

28 Filed Jan. 3, 1952

Answer to the Amended Complaint.

To the Honorable the Judges of the United States District Court for the District of Columbia.

Now comes the defendant, John A. Marzall, Commissioner of Patents, and makes answer to paragraph 12 of the amended complaint as follows:

12. The defendant denies the allegations of paragraph 12 of the amended complaint.

E. L. REYNOLDS
Solicitor, U. S. Patent Office,
Attorney for Defendant.

January 2, 1952

I hereby certify that a copy of the foregoing ANSWER TO THE AMENDED COMPLAINT was handed to the plaintiff today.

E. L. REYNOLDS
Solicitor.

* * * * * * * * * *

29 Filed Jan. 10, 1952

Opinion

This action is brought by the plaintiff, Homer L. Cupples, against the Commissioner of Patents in dual aspect: (1) for mandamus to compel the Commissioner to admit the plaintiff to practice before the United States Patent Office, and (2) for review under 35 U.S.C. § 11, as supplemented by Local Civil Rule 95, of the Commissioner's action denying the plaintiff admission to practice.

In view of the statutory provision for judicial review of the Commissioner's denial of admission to practice, the court holds that mandamus will not lie.

The second aspect of plaintiff's action presents a more difficult problem, namely, the scope of the judicial review provided by 35 U.S.C. § 11. The court has been informed by the plaintiff and counsel for the government that this is the first case where a judicial review of denial of admission has been sought in the District Court pursuant to § 11. Hence, the method by which this court should review the Commissioner's action on the record, as required by Local Civil Rule 95, is a novel question.

Most of the facts in this case are undisputed. On May 22, 1951, plaintiff applied for admission to practice before the United States Patent Office. The plaintiff was
30 admitted to a written examination held on August 6, 1951, in Washington, D. C., to determine his qualifications for admission. Plaintiff attended the examination and wrote answers to every question. Under date of October 30, 1951, the plaintiff was informed by the Chairman of the Committee on Enrollment that he had not attained a passing grade in the examination. On November 3, 1951,

the plaintiff filed a petition to the Commissioner of Patents requesting that he determine the correctness of identity of the examination papers attributed to plaintiff and the correctness of the clerical operations involved in computing and transcribing the grade thereof, and review plaintiff's examination papers on the merits. Under date of November 15, 1951, plaintiff was informed by the Acting Chairman of the Committe on Enrollment that his petition had been referred to the Committee, his examination papers had been reviewed, and the original decision affirmed.

The plaintiff contends that the provision in Rule 341(c) of the Patent Office [37 C.F.R. 1.341(c)] requiring written examinations to determine the scientific and technical qualifications of applicants for admission to practice before the Patent Office, is invalid and void as beyond the authority conferred by 35 U.S.C. § 11; that he should have been admitted to practice on his application and supplemental papers in support thereof; and that his answers to the questions propounded in the written examination entitled him to a passing grade. Further objection to the written examination is made on the ground that the examination paper which plaintiff wrote and submitted has not at all times been kept in the custody of an official of the Patent Office, in that employees of the Civil Service Commission participated in the conduct of the examination.

31 The questions raised as to the authority of and procedure followed by the Patent Office present no difficulty. I hold that the Commissioner has the authority and duty under 35 U.S.C. § 11 to require a written examination when deemed necessary to ascertain the qualifications of applicants for admission to practice before the Patent Office; that Rule 341(c) of the Patent Office* is reasonable and valid and is not discriminatory in that taking

* Rule 341—(c) *Requirements for registration.* No person will be admitted to practice and registered unless he shall apply to the Commissioner of Patents in writing on a prescribed form supplied by the Commissioner and furnish all requested information and material; and shall establish to the satisfaction of the Commissioner that he is of good moral character and of

of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office; that the questions propounded in the examination taken by the plaintiff were pertinent and proper, and that they were reasonable in the sense that they covered subjects in which a prospective practitioner before the Patent Office should be versed. I further find that the examination was prepared and graded by officials of the Patent Office, and that the fact that the actual examination was monitored for the Patent Office by employees of the Civil Service Commission, who delivered the papers to the Patent Office, did not affect the validity of the examination.

32 We come then to the question whether the statutory provision for judicial review of the Commissioner's action, as supplemented by Local Civil Rule 95, requires the court to review the grading of the plaintiff's answers to the written examination and, if so, how far the court should go in such review.

The pertinent part of 35 U.S.C. § 11 provides:

> "The Commissioner of Patents . . . may prescribe rules and regulations governing the recognition of agents, attorneys, or other persons representing applicants or other parties before his office, and may require of such persons, agents, or attorneys, before being recognized as representatives of applicants or other persons, that they shall show that they are of good moral character and in good repute, are possessed of the necessary qualifications to enable them to render to applicants or other persons valuable service, and are likewise competent to advise and assist

---

good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office. In order that the Commissioner may determine whether a person seeking to have his name placed upon either of the registers has the qualifications specified, satisfactory proof of good moral character and repute, and of sufficient basic training in scientific and technical matters must be submitted and an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office.

> applicants or other persons in the presentation or prosecution of their applications or other business before the office . . . The action of the commissioner may be reviewed upon the petition of the person so refused recognition or so suspended or excluded by the district court of the United States for the District of Columbia under such conditions and upon such proceedings as the said court may by its rules determine."

Local Civil Rule 95, adopted by this Court pursuant to the foregoing statute, provides in part:

> "A person refused recognition to practice or suspended or excluded from practice before the Patent Office may file his petition in this court against the Commissioner of Patents for review of such action within thirty days after date of the order recording the Commissioner's action . . . Prior to the time for hearing the petitioner shall file a certified copy of *the record and proceedings before the Patent Office, which shall constitute the sole basis for the court's review.*" (Emphasis supplied.)

In the case at bar, in view of the practice of the Patent Office to regard examination papers and grades thereon as confidential and to refuse applicants access to them, the plaintiff was unable to specify in his petition wherein he contended the officials of the Patent Office had erred in grading his answers, or to file a certified copy of his examination papers with his petition. However, pursuant to an order of the court, which directed that plaintiff be permitted to inspect but not to copy any part of such papers, the Commissioner of Patents has filed a certified
33 copy of the plaintiff's written examination and the grades given thereon.

It is the position of the Commissioner of Patents that the function of the court in reviewing the action of the Commissioner under the provisions of 35 U.S.C. § 11 is not that of a trier of the facts, but is merely to review what has been done to determine whether or not a fair hearing has been had and whether there is substantial evi-

dence to support the action of the Patent Office. With this the court agrees. *Kingsland* v. *Dorsey,* 338 U.S. 318, affirming 69 F. Supp. 788. However, viewing the statute as giving an applicant, as a matter of right, an appeal for judicial review of the Commissioner's action, it seems apparent that in the case of denial of admission on the basis of the applicant's grade on the written examination, in order for such appeal to have any real effectiveness, the court should review the record not only as to the law of the case, but also as to whether there was any substantial basis for the Commissioner's grading of the examination.

The court has therefore adopted what it believes to be one reasonable approach to such review. It obtained from the Patent Office answers to the first thirty-five questions propounded in the examination, which that Office considered correct, together with a copy of the apparatus patent on which the first three questions of Part 2 of the examination were based. It also obtained from the Patent Office the original examination papers of two successful applicants who took the examination at the same time as plaintiff. The court then read all the questions propounded and the plaintiff's answers thereto. As to those questions on which the plaintiff received less than the maximum grade, it has also reviewed the approved answers and the answers of the two other applicants, for the purpose of comparison to see if uniform treatment was afforded the applicants.

34 The first part of the examination consisted of thirty-five questions as to law and practice, and the second part six questions designed to test the applicant's knowledge of the preparation of apparatus and process claims. The plaintiff passed the first part, but failed the second. The Patent Office requires passage of both parts of the examination in order for an applicant to be admitted to practice. Although the plaintiff passed the first part, the court reviewed the questions therein and answers by the plaintiff and the two other applicants as background in

determining whether fair treatment was accorded the plaintiff.

On such comparison of both parts of the examination, the court finds that the standards for marking the examination papers was uniform; that such standard was applied in marking plaintiff's examination papers; that the marking of plaintiff's examination papers was honest and reasonable; that the plantiff was in no wise discriminated against; and that the over-all grade which plaintiff received was below the mark established as a passing grade.

By this the court does not mean, nor does it construe the law to require, that had the court marked the papers originally, it would have arrived at the identical grade awarded by the Patent Office officials. The court does mean that its examination of the records has caused it to conclude that, by reasonable tests, the officials of the Patent Office acted fairly and without discrimination in the grading of the plaintiff's examination, pursuant to a uniform standard, that the plaintiff failed to pass the required examination, and therefore he has not made such a showing of the necessary qualifications as to entitle him to be admitted to practice before the Patent Office.

Since the primary responsibility for protection of
35 the public from unqualified practitioners before the Patent Office rests in the Commissioner of Patents, not in the courts, and it appears that there was a reasonable basis for the action of the Commissioner denying the plaintiff admission to practice, the court will not disturb the Commissioner's action. *Kingsland* v. *Dorsey,* supra.

This court is conscious that the method of review herein followed places quite a burden upon the court, but anything short thereof would not, in its opinion, have satisfied the mandate of Congress as prescribed by 35 U.S.C § 11. This court questions the desirability of the present provision for judicial review of the Commissioner's action, unrestricted save by Local Rule 95, as applied to appeals from denial

of admission to practice for failure to pass the required written examination.

Counsel will prepare and submit appropriate findings of fact, conclusions of law, and judgment for the defendant.

(Signed) R. B. KEECH
Judge.

January 9, 1952.

36 Filed Jan. 18, 1952

Findings of Fact

1. This action is brought by the plaintiff, Homer L. Cupples, against the Commissioner of Patents in dual aspect: (1) for mandamus to compel the Commissioner to admit the plaintiff to practice before the United States Patent Office, and (2) for review under 35 U.S.C. 11, as supplemented by Local Civil Rule 95, of the Commissioner's action denying the plaintiff admission to practice.

2. On May 22, 1951, plaintiff applied for admission to practice before the United States Patent Office. The plaintiff was admitted to a written examination held on August 6, 1951, in Washington, D. C., to determine his qualifications for admission. Plaintiff attended the examination and wrote answers to every question. Under date of October
37 30, 1951, the plaintiff was informed by the Chairman of the Committee on Enrollment that he had not attained a passing grade in the examination. On November 3, 1951, the plaintiff filed a petition to the Commissioner of Patents requesting that he determine the correctness of identity of the examination papers attributed to plaintiff and the correctness of the clerical operations involved in computing and transcribing the grade thereof, and review plaintiff's examination papers on the merits. Under date of November 15, 1951, plaintiff was informed by the Acting Chairman of the Committee on Enrollment that his petition had been referred to the Committee, his examination papers had been reviewed, and the original decision affirmed.

3. The examination was prepared and graded by officials of the Patent Office and was monitored by employees of the Civil Service Commission, who delivered the papers to the Patent Office. The papers were identified by numbers and were graded without knowledge of the identity of the person whose paper was being graded.

4. The examination was divided into two parts, with perfect grades on the first part totaling seventy and on the second part thirty. In order to pass it was necessary for an applicant to obtain at least forty-two points on the first part and at least eighteen points on the second part, and also, to obtain a total of at least seventy points on the two parts combined.

5. The plaintiff was accorded a total of fifty-five
38 points on the first paper and thirteen on the second. He therefore failed to achieve either the total passing grade or the minimum allowable grade for the second part of the examination.

6. The questions propounded in the examination were pertinent and proper and were reasonable in the sense that they covered subjects in which a prospective practioner before the Patent Office should be versed.

7. The standard applied by the Patent Office in marking the examination papers was uniform and proper and such standard was applied in the marking of the plaintiff's paper.

8. The marking of plaintiff's examination papers was honest and reasonable and plaintiff was in no wise discriminated against.

9. The over-all grade which the plaintiff received was below the mark established as a passing grade.

10. Subsequent to the time when plaintiff took the written examination and until the filing of the complaint in this action, the Patent Office refused to allow plaintiff to inspect

his examination papers or to have copies thereof. However, plaintiff was supplied with a certified copy of the record of the proceedings relative to his application for registration to practice before the Patent Office, excluding his examination papers, and plaintiff was permitted
39 to inspect the last-mentioned papers prior to the trial.

11. A certified copy of the plaintiff's examination papers and the grades given him on each question by the grading officials of the Patent Office were presented to the Court at the trial, and these papers together with the certified copy of the record previously furnished plaintiff by the Patent Office constitute the complete record of the proceeding before the Patent Office.

12. The decison of the Patent Office that the plaintiff failed to attain a passing grade on the examination was reasonable and proper.

Conclusions of Law

1. In view of the statutory provision for judicial review of the Commissioner's denial of admission to practice, mandamus will not lie.

2. The Commissioner of Patents has the authority and duty under 35 U.S.C. 11 to require a written examination when deemed necessary to ascertain the qualifications of applicants for admission to practice before the Patent Office.

3. Rule 341(c) of the Patent Office is reasonable and valid and is not discriminatory in that taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office.

40 The fact that the examination, which was prepared and graded by employees of the Patent Office, was monitored by employees of the Civil Service Commission does not affect its validity.

5. The function of the court in reviewing the action of the Commissioner under the provisions of 35 U.S.C. 11 is not that of a trier of the facts, but is merely to review what has been done to determine whether or not a fair hearing has been had and whether there is substantial evidence to support the action of the Patent Office.

6. In a case involving an issue as to the propriety of the grades given on an examination of an applicant for registration, the court should review the record not only as to the law of the case but also as to whether there was any substantial basis for the Commissioner's grading.

7. The refusal of the Commissioner of Patents to register the plaintiff for practice before the Patent Office was proper.

8. The complaint should be dismissed.

R. B. KEECH,
Judge

41 Filed Jan. 18, 1952

Judgment

This action came on to be heard at this term and thereupon upon consideration thereof, it is this 18th day of January, 1952

ADJUDGED that the complaint be and it is hereby dismissed, with costs against the plaintiff.

R. B. KEECH,
Judge

APPROVED AS TO FORM:
HOMER L. CUPPLES
Attorney for Plaintiff

2486-10-107

United States Court of Appeals for the District of Columbia Circuit

United States
District of
FILED MAY

APPEAL No. 11401

HOMER L. CUPPLES, *Appellant*,

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,
Appellee.

703

Appeal from the Judgment of the United States District Court for the District of Columbia Circuit

E. L. REYNOLDS,
Solicitor, United States Patent Office,
Attorney for Appellee.

APPEAL NO. 11401

STATEMENT OF QUESTION PRESENTED

In the opinion of the appellee, the question presented is the Commissioner of Patents properly required that the appellant should take and pass a proper examination as a prerequisite to granting him registration to practice before the Patent Office.

SUBJECT INDEX

	Page
Introduction	1
Summary of Argument	2
Argument	2
Conclusion	6

TABLE OF STATUTES AND RULES

Revised Statutes, Sec. 487 2

Rules of Practice of the United States Patent Office in Patent Cases, Rule 341(c) 2, 3, 4

Rules of the United States District Court for the District of Columbia, Rules 93(c) and 93(g) 5

United States Court of Appeals for the District of Columbia Circuit

---

APPEAL NO. 11401

HOMER L. CUPPLES, *Appellant,*

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS, *Appellee.*

Appeal from the Judgment of the United States District Court for the District of Columbia Circuit

---

BRIEF FOR THE COMMISSIONER OF PATENTS

INTRODUCTION

The appellant has been refused registration to practice before the Patent Office, for the reason that he failed to pass an examination which was duly given to determine the qualifications of applicants for registration. The court below found in its findings of fact Nos. 6 to 9 (appendix, page 18) that the examination was pertinent, proper and reasonable, that it was fairly and uniformly graded, and that the appellant

failed to attain the passing grade. Those findings do not appear to be controverted by the appellant and the only issue, therefore, is whether it was proper to give the examination at all.

SUMMARY OF ARGUMENT

1. Section 487 of the Revised Statutes provides that the Commissioner of Patents may prescribe rules and regulations governing the admission of persons to practice before the Patent Office and may require such persons to show that they are possessed of the necessary qualifications.

2. A pertinent examination is the most obvious and impartial means of determining qualifications.

3. The provision of Patent Office Rule 341(c) that the taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office is entirely reasonable and proper.

4. Even if the exemption last referred to were improper, that would not justify the admission of the appellant to practice without an examination.

ARGUMENT

The statute applicable here appears on pages 4 and 5 of the appellant's brief. It expressly provides that the Commissioner may make rules and regulations governing the recognition of persons to practice before his Office and may require them to show that they are qualified. On the basis of that authority, the Commissioner, with the approval of the Secretary of Com-

merce, has promulgated Rule 341(c) which is as follows:

> "No person will be admitted to practice and registered unless he shall apply to the Commissioner of Patents in writing on a prescribed form supplied by the Commissioner and furnish all requested information and material; and shall establish to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office. In order that the Commissioner may determine whether a person seeking to have his name placed upon either of the registers has the qualifications specified, satisfactory proof of good moral character and repute, and of sufficient basic training in scientific and technical matters must be submitted and an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has served for three years in the examining corps of the Patent Office."

Since the rule relates to a subject on which the Commissioner is expressly authorized by law to make rules, it is evident that, in the absence of a showing of clear abuse of discretion, the rule must be considered proper.

It is thought that there can be no serious contention that, as a general proposition, a written examination is an eminently proper means of determining whether an applicant for a privilege or position is qualified. This is the method almost universally employed not only by schools and colleges, but by the Civil Service Commission and Bar Admission Committees. It is scarcely conceivable, therefore, that it could be held that the Commissioner's action in providing for such an examination in carrying out his statutory duty to see that applicants for registration are qualified, constituted an abuse of discretion.

The appellant does not appear to contend that the requirement for an examination is improper per se, but seems to argue that the provision that persons who have served as examiners for three years may be admitted without examination vitiates the entire rule 341(c). The provision, it is submitted, is entirely fair and proper. The statute merely provides that the Commissioner may require applicants to show that they are qualified. The work of the examining corps of the Patent Office is closely related to the prosecution of cases before that Office, and the examiners are under the supervision of the Commissioner. Moreover, persons are required to establish that they have certain technical qualifications before they may be appointed to the examining corps. It seems evident, therefore, that the Commissioner is familiar with the qualifications of one who has served for three years as an examiner, and that it is therefore unnecessary to require such a person to take an examination.

It is to be noted that similar provision for the exemption from examinations of persons whose qualifications are already established are conventional. Rules 93(c) and 93(g) of the United States District Court of the District of Columbia are in point. The former accepts high school graduates as meeting certain requirements, but provides for an examination of others who are not graduates but who claim to have the same qualifications, while the latter provides for the admission without examination of certain classes of persons who, presumably, are considered to be clearly qualified. It is submitted that the provision here under consideration is a reasonable one for avoiding unnecessary work by both the Patent Office and the persons involved, in the taking and grading of an examination designed to show qualifications which have already been demonstrated.

Moreover, even if it could be assumed that the admission of former Patent Office examiners without examination is unreasonable, it is not apparent how the appellant would be benefited. If that exemption is improper, then the remedy is not to waive the examination for everyone, but to require everyone to take it. Since the Commissioner had no knowledge of the appellant's qualifications prior to his application for registration, it was not only his right, but his duty, to inquire into that matter. This was done by means of an examination which the court below has found to have been proper and fairly graded, and on which the appellant did not attain the passing grade. Under these circumstances it is submitted that it would be

clearly improper for the Court to direct that the appellant be registered.

CONCLUSION

The rules and regulations governing the admission of persons to practice before the Patent Office are proper and conformable to the requirements of law, and they have been fairly applied in the present case. The appellant's contention that he should be registered notwithstanding his failure to comply with those requirements is therefore without merit and his complaint was properly dismissed by the court below.

Respectfully submitted,

E. L. REYNOLDS,
Solicitor, United States Patent Office.

JUNE 1952.

☆ U.S. GOVERNMENT PRINTING OFFICE 1952—207405/P.O.1222